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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,548	10/22/1999	DAVID ROBBINS	DEX-0054	2041

7590 11/28/2003
JANE MASSEY LICATA
66 E MAIN STREET
MARLTON, NJ 08053

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/426,548	Applicant(s) ROBBINS ET AL.	
	Examiner Joseph T. Voitach	Art Unit 1632	

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 2 and 3.

Claim(s) rejected: 9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Deborah Crouch
DEBORAH CROUCH
PRIMARY EXAMINER
 GROUP 1800 1630

Continuation of 2. NOTE: Amending the claims would not obviate the basis of the rejection. Further, while a product must have only one enabled use, amending the method claims would require search and further consideration for specific sequences which meet the functional limitations for rejections made under 35 USC 112 and 35 USC 102/103. For example the sequences of MSH and MLH as well as specific mutations in said sequence associated with cancer were known in the prior art, and it would require further consideration to whether these sequences would meet the structural limitations of the claims. Further, it would require consideration of the new metes and bounds of the method claims for what 'complementary' sequences could be used.

Continuation of 5. does NOT place the application in condition for allowance because: Amending claims 2 and 3 to include the limitation of claim 9 has not obviated the basis of the rejection for claim 9, only shifted it into these claims. While cancellation of claim 9 would render the rejection moot, the rejection would apply equally to the newly amended claims. No specific arguments have been presented i traverse of the basis of the rejection made under 35 USC 112, therefore, it is maintained for the reasons of record.